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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,141	04/23/2001	Shuichi Shiitani	1359.1044	1624

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/839,141

**Applicant(s)**

SHIITANI ET AL.

**Examiner**

Matthew s Gart

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date Paper No. 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group 1 (claims 1-10 and 17-20) in the Attorney's Response to Restriction Requirement dated May 26, 2004 is acknowledged. Claims 11-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 1-20 are pending in the instant application.

### ***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

**Claims 1-10 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "A online

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shopping method and/or system." mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or affect the underlying process.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-10 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Abekawa U.S. Patent Application Publication US2002/0156703.**

Referring to claim 1. Abekawa discloses an online shopping method, comprising:

- Previously generating/preparing article data in which features of an article and a data sending rank are related to each article picture as additional information (paragraph 0049 and paragraph 0065);
- Upon receiving an article search by a user, generating article picture arrangement data in which article pictures similar to each other in the features are disposed at close positions, as search results of the article data (paragraph 0067 through paragraph 0071 and paragraph 0075 through paragraph 0076);

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- Sending the article picture arrangement data to a user terminal so that each article picture data is successively sent in accordance with the data sending rank (paragraph 0067 through paragraph 0071 and paragraph 0075 through paragraph 0076); and
- At the user terminal, displaying each article picture data at each arrangement position on a screen of search results in a receiving order, thereby displaying an article picture with a higher data sending rank earlier at the arrangement position (paragraph 0075 through paragraph 0076).

Referring to claim 2. Abekawa further discloses an online shopping method wherein the features of the article are any one selected from the group consisting of features of an article picture of the article, a keyword representing the features of the article, and article classification information regarding classification of the article in accordance with the features thereof, or a combination thereof (Table 1, Table 2 and Table 3).

Referring to claim 3. Abekawa further discloses an online shopping method wherein the data sending rank is determined by an article provider (paragraphs 0066).

Referring to claim 4. Abekawa further discloses an online shopping method wherein a service user previously selects items to be considered in purchasing an article and notifies a service provider of the selection, and the service provider determines the data sending rank in accordance with the notified items (Table 1, Table 2 and Table 3).

Referring to claim 5. Abekawa further discloses an online shopping method wherein a service provider previously analyzes items considered by a service user based on a past search history and a past purchase history of the service user, and the service provider determines the data sending rank in accordance with the analyzed items (Table 1, Table 2 and Table 3).

Referring to claim 6. Abekawa further discloses an online shopping method wherein a screen of article search results is presented to an article provider, and the article provider specifies a picture of an article which the article provider provides on the presented screen of article search results, thereby making it possible to access selling information of the article (paragraph 0067 through paragraph 0071 and paragraph 0075 through paragraph 0076).

Referring to claim 7. Abekawa further discloses an online shopping method wherein the data sending rank is determined by an article provider (paragraph 0066).

Referring to claim 8. Abekawa further discloses an online shopping method wherein a service user previously selects items to be considered in purchasing an article and notifies a service provider of the selection, and the service provider determines the data sending rank in accordance with the notified items (Table 1, Table 2 and Table 3).

Referring to claim 9. Abekawa further discloses an online shopping method wherein a service provider previously analyzes items considered by a service user based on a past search history and a past purchase history of the service user, and the

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service provider determines the data sending rank in accordance with the analyzed items (Table 1, Table 2 and Table 3).

Referring to claim 10. Abekawa further discloses an online shopping method wherein a screen of article search results is presented to an article provider, and the article provider specifies a picture of an article which the article provider provides on the presented screen of article search results, thereby making it possible to access selling information of the article (paragraph 0067 through paragraph 0071 and paragraph 0075 through paragraph 0076).

Referring to claims 17-20. Claims 17-20 are rejected under the same rationale as set forth above in claims 1-10.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bailey et al., Patent Application Publication, Pub. No. US2002/0062258 A1, May 23, 2002, discloses a computer-implemented procurement of items using parametric searching.

Burnett, Patent Application Publication, Pub. No. US2002/0087408 A1, July 4, 2002, discloses a system for providing information to intending consumers.

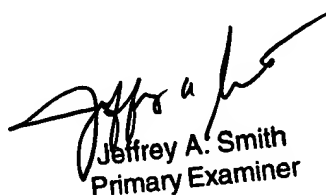
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
June 3, 2004



Jeffrey A. Smith  
Primary Examiner